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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,567	01/31/2006	Ralf Franzgrote	40149/01101	6155

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NEW YORK, NY 10038

EXAMINER
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PIERY, MICHAEL T

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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07/07/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,567	<b>Applicant(s)</b> FRANZGROTE, RALF	
	<b>Examiner</b> MICHAEL T. PIERY	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-40 and 47 is/are pending in the application.
- 4a) Of the above claim(s) 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claim 47 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 47 is directed to a surface décor for a trim part (a product) which is a different statutory class of invention than the process of claims 26-40.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 47 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 26-29, 31, 32, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwaighofer (US 2002/0053750) in view of Duriez (EP 0786380 (citations refer to attached machine translation)).

Regarding claim 26, Schwaighofer teaches introducing a décor inlay into a space between upper and lower tools of a casting tool (figure 2, #30,32), clamping an edging of the décor inlay between the upper and lower tools so that the edging projects into a cavity formed between the upper and lower tools and corresponding to the second region of the surface décor (figure 2), a remaining portion of the décor inlay being accommodated outside the cavity (14), the cavity being sealed at a location where the décor inlay is clamped between the upper and lower tools, and filling the cavity between the upper and lower tools with a curing material to form the cast skin enclosing the edging after the decor inlay has been clamped between upper and lower tools (figure 2). Schwaighofer, does not explicitly teach the edging is enclosed by the curing material. Duriez, however, teaches it is known to enclose an edging of a decor inlay with the curing material (figure 4). It would have been obvious to one of ordinary skill in the art at the time of

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the invention to modify the process of Schwaighofer to enclose the edging because enclosed edging is desirable for inner doors of vehicles (page 1 of Duriez).

Regarding claim 27, the trim part is part of a motor vehicle (paragraph 0005).

Regarding claim 28, the curing material includes polyurethane (paragraph 0005).

Schwaighofer does not explicitly teach the claimed thickness. It would have been obvious, however, to one of ordinary skill in the art at the time of the invention to modify the process of Schwaighofer to use a thickness between 0.7 and 1.5 mm because it has been held that where the general conditions of a claim are disclosed, finding the optimum workable range involves only routine skill in the art (MPEP 2144).

Regarding claim 29, a paint layer is deposited onto the surface of the tool before filling the cavity (paragraph 0020).

Regarding claim 31, the lower tool includes a web along a line separating the cavity from non-edge portions of the décor inlay where the edging of the inlay is clamped between the web and the upper tool, the upper tool having a recess for the web (figure 2).

Regarding claim 32, Schwaighofer does not explicitly teach the claimed thickness or height. It would have been obvious, however, to one of ordinary skill in the art at the time of the invention to modify the process of Schwaighofer to use a thickness between 0.7 and 1.5 mm and a height between 3 mm and 10 mm because it has been held that where the general conditions of a claim are disclosed, finding the optimum workable range involves only routine skill in the art (MPEP 2144).

Regarding claim 36, the inlay forms a middle region of the surface décor encased by the cast skin (figure 3).

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Regarding claim 37, the inlay is polymer (paragraph 0005).

Regarding claim 38, the rear side of the inlay includes a coating (paragraph 0011).

Regarding claim 39, the rear side of the inlay includes a foam-tight material (paragraph 0022).

4. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwaighofer (US 2002/0053750) in view of Duriez (EP 0786380 (citations refer to attached machine translation)), as applied above to claim 26, and further in view of Ota et al. (US 5,811,053).

The modified Schwaighofer reference teaches the method of claim 26, as applied above.

Regarding claim 34, Schwaighofer does not explicitly teach using a vacuum to hold the inlay. Ota, however, teaches it is well-known to hold an inlay using a vacuum (column 6, lines 40-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process of Schwaighofer to use the vacuum of Ota because the vacuum improves the placement accuracy of the inlay in the mold.

5. Claims 30, 33, 35 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwaighofer (US 2002/0053750) in view of Duriez (EP 0786380 (citations refer to attached machine translation)), as applied to claims 26 and 31 above, and further in view of Spengler (US 6,214,157).

The modified Schwaighofer reference teaches the method of claims 26 and 31, as applied above.

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Regarding claims 30 and 33, Schwaighofer does not explicitly teach divided regions of the tool. However, Spengler teaches the upper and lower tools are divided such that the regions are liftable and lowerable (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process of Schwaighofer to include the movable mold of Spengler because the mold of Spengler prevents the undesirable appearance of the groove (Column 2, lines 1-19).

Regarding claim 35, Spengler teaches providing a positioning pin (Figure 2 #7). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate multiple positioning pins since it has been held that duplication of parts is within routine skill of one in the art.

Regarding claim 40, Spengler teaches pushing together the joint to minimize the gap (Column 6, lines 19-33).

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. PIERY whose telephone number is (571)270-5047. The examiner can normally be reached on M-Th 8:30-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael T Pierey/  
Examiner, Art Unit 1791

/Monica A Huson/  
Primary Examiner, Art Unit 1791